

REMARKSRegarding the Amendments to the Claims

By the above amendment, Claims 131-151 are presented in the case. Claims 71-130 have been withdrawn from consideration in the Office Action of May 8, 2009. In effecting the withdrawal, the Examiner noted that (a) Claims 71-130 replace the Br₂ in the originally filed claims with BrCl, and (b) the claims as amended would produce chlorosulfamate once BrCl reacts with sulfamate whereas the Br₂ would only yield bromosulfamate once Br₂ reacts with sulfamate. Claims 131-151 added by this amendment are directed to the originally presented invention of using bromine in the process.

Subject matter of withdrawn Claims 71-130 is being carried forward in a continuing application containing 20 claims, and which is being filed contemporaneously with this response. This will afford the opportunity for cancellation of the withdrawn claims at an appropriate stage in the Examination of this application.

It is believed that Claims 131-151 are supported by the original disclosure, especially since the purpose of the amendments is to pursue a scope of the invention relating to use of bromine alone as the brominating agent or bromine source of the active bromine, a feature which is described in the present application. This feature is not specifically claimed in any of the U.S. patents and U.S. applications related to the present application, with the exception of U.S. Pat. No. 7,195,782 and U.S. Patent Application Publication No. 2004/0022874. For purposes of full disclosure, Applicants note that the patents and applications related to the present application include: U.S. Patent Nos. 6,068,861, 6,299,909, 6,306,441, 6,322,822, 6,348,219, 6,352,725, 6,495,169, 6,506,418, 6,511,682, 6,652,889, 7,087,251 and 7,195,782; and currently pending U.S. Serial Nos. 09/785,890 and 10/282,290. Another member of this group is U.S. Serial No. 10/703,311 which was published on July 7, 2005 as U.S. 2005/0147696 A1, and which has been abandoned.

Support for Claims 131 and 132 appears, for example, at page 11, lines 2-16; page 5, lines 10-21; original Claim 1, line 1; and former Claim 61. Support for Claim 133 appears, for example, at page 4, lines 18-20; at page 5, line 13; page 6, lines 15-16; and former Claim

64. Support for Claim 134 appears, for example, at page 11, lines 2-16. Claims 135-151 correspond to and thus are fully supported by original Claims 13-29, respectively, which were cancelled from the present application in April 2001 without prejudice or disclaimer, and prior to receiving a first Office Action. In this connection, Claims 135-151 are designated as “(New)” claims even though they were previously presented because they were cancelled without prejudice or disclaimer before any Examination thereof, a situation which does not appear to be covered by the “Revised Amendment Practice” issued by the USPTO on 06/30/03. In effect, Claims 131-151 are being “reinserted” into the application.

Applicants note that at the time of filing the present application, claim fees for 60 claims (including for 6 independent claims) was paid. Since by the current amendment, only 21 claims will be pending (only 3 of which are independent), no additional claim fees are believed due.

Regarding Patentability Over the Prior Art

In an amendment submitted in this application under 37 C.F.R. §1.607 dated April 10, 2007, original Claims 1-60 of this application were cancelled without prejudice or disclaimer of the subject matter thereof. This amendment occurred prior to receipt of an Office Action in this application. The foregoing amendment presented Claims 61-65 for purposes of seeking an interference with U.S. Pat. No. 6,156,229. Support for Claims 61-65 was presented in that amendment and subsequently, an Interference was declared (Patent Interference No. 105,223). In that Interference, Claims 10-17 of U.S. Pat. No. 6,156,229 were held unpatentable under 35 U.S.C. §§ 102 and 103 as either anticipated by or obvious over certain prior art. In addition, although it was held that the present Applicants did not adequately rebut the presumption that Claims 61-65 were unpatentable over U.S. Pat. No. 3,558,503 (to Goodenough et al.), the Board of Patent Appeals and Interferences modified that decision *sua sponte* by vacating the previous judgment against Moore’s Claims 61-65 as being unpatentable over the prior art and entered a recommendation pursuant to 37 C.F. R. 41.127(c) as they had relied on evidence in addition to Goodenough. The recommendation by the Board recommended that the Examiner enter and maintain a new ground of rejection based on the Finding of Fact and Conclusions of Law set forth on pages 5-18 of the

“Decision - Rehearing - Bd. R. 125(c) (Including Recommendation to Examiner - Bd. R. 127(c))”, a copy of which is of record and attached to the Office Action of 10/21/2008.

By the above amendments, original Claims 61, 62, 64, and 65 are presented as new Claims 131-134 respectively. These new claims are submitted to be patentable despite the Board's Findings of Fact and Conclusions of Law which referred to original Claims 61-65. In particular, Claim 131 which is generic to Claims 132-134 reads as follows:

A process of producing a concentrated, stabilized liquid biocide formulation which consists of the step of preparing the concentrated stabilized liquid biocide formulation by the step consisting of cofeeding to a reactor containing an aqueous solution formed from water, sulfamic acid and alkali metal base, (i) bromine and (ii) a solution of alkali metal base that maintains the pH of said concentrated, stabilized liquid biocide formulation produced in the reactor in the range of from about 12 to about 14.

Claim 131 makes clear that the manner in which the product formulation is produced consists of preparing the formulation by the step consisting of cofeeding the specified materials to a reactor containing specified materials so that in effect, at all times during and after the feeding the pH of the formulation is always in the range of about 12 to about 14. The claim thus does not permit a subsequent addition of base to achieve the pH in the range of about 12 to about 14. That pH is accomplished only in the preparation process step as claimed. Since the formulation can be prepared only by the process as claimed, other steps that do not involve preparing the formulation can be practiced without avoiding the claim. Non-limiting examples of such other steps are removing the product from the reactor after the process has been completed, or introducing water, sulfamic acid and alkali metal base into the reactor to provide the initial reactor contents prior to conduct of the claimed process.

Consequently, Claims 131-134 present an entirely different situation from that upon which the Board's Findings of Fact and Conclusions of Law were based. For example, on page 14 the Board stated as follows:

“Hence, one of ordinary skill in the art would have been led to combine the teachings of Goodenough and Dallmier [U.S. Pat. No. 5,683,654]. Specifically, one of ordinary skill in the art would have found it

prima facie obvious to modify Goodenough's process to include a further step of increasing the pH of the final solution to 12-14 as suggested by Dallmier in order to minimize the formation of the suspected carcinogen bromate during storage, thus arriving at the method encompassed by Moore's involved claims." [Emphasis added]

Since present Claims 131-134 do not permit the inclusion of a further step of increasing the pH of the final solution to 12-14, the Board's contention as regards the combination of Goodenough and Dallmier is inapplicable. We submit that one skilled in the art would not find it obvious from Goodenough and Dallmier to conduct the process in the presently-claimed manner of any of Claims 131-134.

Indeed, the Board's Decision appears to provide support for the patentability of present Claims 131-134 because on page 16 of the Board's Decision, we find the following:

"Moore argues that "the 'pH of the resulting biocidal composition' [recited in Moore's claims] necessarily is the pH after the bromine has been mixed with the aqueous solution." (Request for Rehearing of the Decision on Moore PM3 at 3.) We generally agree with Moore's proposed construction of this claim language but only to the extent that the claims do not exclude a process that includes a further step of increasing pH to 12-14 after the recited step of mixing bromine with the aqueous solution. In other words, the recited pH may be obtained after performing a further step of increasing pH as suggested by Dallmier. The use of the transitory term 'comprises' to define the steps of the claimed process does not exclude such an additional step." [Single line emphasis was by the Board; the double line emphasis is presently added by the undersigned]

In as much as Claims 131-134 no longer use the transitory term "comprises" to define the single step of the claimed process of preparing the product formulation, it appears that the underlying basis for the Board not to fully agree with Moore's above quoted argument has been satisfied by these claims in their present form. In any event, it is respectfully submitted that Claims 131-134 set forth subject matter which is entitled to the patent grant, the Board's Decision referred to above, and the reasons given therein, notwithstanding. Accordingly, favorable action on Claims 131-134 is requested.

Since (a) the subject matter of Claims 135-151 has not received any Examination or Office Action from the Office, (b) these claims specify modes of operation not involved in the Interference subject matter, and (c) these claims are deemed to be directed to novel and patentable subject matter, it is believed that no further comments are required at this time as regards patentability.

Accordingly, favorable action on Claims 131-151 is earnestly solicited.

If matters remain requiring further consideration, the Examiner is respectfully requested to telephone the undersigned so that such matters may be discussed and, if possible, can be promptly resolved.

Please continue to address all correspondence in this Application to Albemarle Corporation, at their address of record.

Respectfully submitted,
/John F. Sieberth/
John F. Sieberth
Reg. No. 17,704
McGlinchey Stafford, PLLC
Attn: IP Group
301 Main Street, Fourteenth Floor
Baton Rouge, LA 70802

Telephone: 225-383-9000
Facsimile: 225-343-3076